UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,950	09/30/2005	Timothy P. Tully	17VV-137227	1059

68850 7590 08/24/2009

DON J. PELTO
Sheppard, Mullin, Richter & Hampton LLP
1300 I STREET, NW
11TH FLOOR EAST
WASHINGTON, DC 20005

EXAMINER	
DUTT, ADITI	

ART UNIT	PAPER NUMBER
1649	

MAIL DATE	DELIVERY MODE
08/24/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	10/527,950	TULLY ET AL.	
	Examiner	Art Unit	
	ADITI DUTT	1649	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 July 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

   a) ☒ The period for reply expires *3* months from the mailing date of the final rejection.

   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *1-4,6-10,12-15,19-22 and 24*.
   Claim(s) withdrawn from consideration: *17,18 and 25*.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See continuation belos.

12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

/Jeffrey Stucker/
Supervisory Patent Examiner, Art Unit 1649

/A. D./
Examiner, Art Unit

Continuation of 11 : Does not place the application for condition of allowance because:

103(a)

Rejection of claims 1, 3-4, 6-7, 9-10, 12, 14-15 over Sheriff et al., (Reg Pept 75-76: 309-318, 1998), in view of Herzog et al. (PNAS 89: 5794-5798, 1992) is maintained.
Applicant alleges that Examiner's stand with regards to the limitation in claim 1 reciting "repeating steps a) to d) with a range of different concentrations ....." as not critical, amounts to reading the element of out of the claim, which is impermissible. Applicant asserts that the above claimed element is not referring to "optimum or workable ranges" but is focussing on "repeating the steps of the claimed method with a range of different concentrations of the test compound". Applicant further argues that the Kerkhoven citing is inapposite because it recites a process of creating a composition of matter, while Applicants are claiming a method of screeening. Moreover, Applicant alleges that the Examiner fails to provide evidence showing that the prior art teaches or suggests hippocampal neurons, or "screening a plurality of compounds".
Applicant's arguments are considered, however, are not found to be persuasive. The element of repeating the steps "a) to d)" using different concentrations of the test compound is a routine experimentation step in screening procedures performed by a person skilled in the art. It is implicit that the testing of different concentrations (or different test compounds) would involve repitition of the method steps, which would indicate a dose dependent effect for a workable range of concentrations, to enable proper selection of the test compound. As stated in the previous Office Action it is repeated that since the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the workable ranges in a screening protocol by routine experimentation involving repitition of method steps.
Applicant's arguments that Kerkhoven is inapposite is mistaken. Sheriff et al demonstrate that Y1 gene expression is enhanced by NPY and by forskolin individually. It would have therefore, been obvious to try to contact cells with both NPY and forskolin because the idea of doing so would have logically followed from their having been individually taught in the prior art to be useful as compounds for the same purpose of enhancing CREB dependent gene expression.
Furthermore, although the references do not teach hippocampal neurons or explicitly recite "screening a plurality of compounds", it would be obvious to modify the teachings in the art, primarily because the hippocampus like neuroblastoma is of neural origin comprising neurons, and further because Y1 is present in the hippocampus. Additionally based upon the functional diversity of the NPY-Y1 receptor coupled to various second messenger systems in different cells as taught by Herzog et al., the person of ordinary skill would be certainly motivated to try screening for various compounds for the development of different therapeutic drugs with reasonable success (also suggested by Herzog et al.). Lastly, as stated in the previous Office Action, the phrase "screening a plurality of compounds" is merely part of the preamble of the claim reciting the screening method that reflects a general feature of any screening protocol without providing further limitations to the invention, therefore, is of no significance to claim construction.

Rejection of claims 19(a-k) and 20-22 and 24 over Sheriff et al., (Reg Pept 75-76: 309-318, 1998), in view of Herzog et al. (PNAS 89: 5794-5798, 1992), and further in view of Barad et al. (PNAS 95: 15020-15025, 1998) is maintained.
Applicant's arguments are the same as stated above. In addition, Applicant asserts that Examiner fails to provide evidence showing that the prior art suggests or teaches substituting hippocampal neurons for hippocampal slices.
Applicant's arguments are fully considered, but not found to be persuasive for the same reasons as stated above. Additionally, as stated in the previous Office Action, the skilled artisan would have reasons to substitute hippocampal neurons for hippocampal slices, particularly because neurons are individual cells that would elicit the CREB dependent gene expression in a cell specific manner, thus negating the interference from surrounding organelles and biomolecules of tissues.

Rejection of claims 2, 8 and 13 over Sheriff et al., (Reg Pept 75-76: 309-318, 1998), in view of Herzog et al. (PNAS 89: 5794-5798, 1992), and further in view of Barad et al. (PNAS 95: 15020-15025, 1998) is maintained.
Applicant's arguments are essentially the same as in the previous two rejections, which have been fully considered but not found to be persuasive for reasons stated above. Furthermore, Applicant's allegation that Examiner's reading the element of adding the compound prior to the CREB function stimulating agent as not critical is impermissible, is not convincing. Because the disclosure does not specify criticality of the claimed sequence of addition of the test/candidate compound and the CREB function stimulating agent, optimization within prior art conditions or through routine experimentation is obvious to one skilled in the art. The person of ordinary skill in the art would be motivated, to assess the optimum conditions to achieve the desirable increase in CREB function.